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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/719,771	11/21/2003	Richard D. Ellison	200308979-1	3099
22879 7590 08/26/2010 HEWLETT-PACKARD COMPANY Intellectual Property Administration 3404 E. Harmony Road Mail Stop 35 FORT COLLINS, CO 80528				
EXAMINER JAMAL, ALEXANDER				
ART UNIT 2614		PAPER NUMBER		
NOTIFICATION DATE 08/26/2010		DELIVERY MODE ELECTRONIC		

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UNITED STATES PATENT AND TRADEMARK OFFICE

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BEFORE THE BOARD OF PATENT APPEALS  
AND INTERFERENCES

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*Ex parte* RICHARD D. ELLISON

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Appeal 2009-007209  
Application 10/719,771  
Technology Center 2600

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Before ROBERT E. NAPPI, KENNETH W. HAIRSTON, and  
MAHSHID D. SAADAT, *Administrative Patent Judges*.  
HAIRSTON, *Administrative Patent Judge*.

DECISION ON APPEAL<sup>1</sup>

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<sup>1</sup> The two-month time period for filing an appeal or commencing a civil action, as recited in 37 C.F.R. § 1.304, or for filing a request for rehearing, as recited in 37 C.F.R. § 41.52, begins to run from the “MAIL DATE” (paper delivery mode) or the “NOTIFICATION DATE” (electronic delivery mode) shown on the PTOL-90A cover letter attached to this decision.

This is an appeal under 35 U.S.C. §§ 6(b) and 134 from the final rejection of claims 1 to 37. We will reverse.

The disclosed invention relates to a gain controller, gain control system and method for providing gain control to a voice data source that is then input into a Public Switched Telephone Network (PSTN) (*see* Fig. 2 and Spec. 6:30-7:8). Gain control is performed on a voice signal stream “before the outgoing voice signal stream enters the output channel in communication with the PSTN” (Fig. 2; claims 1, 7, 21, 27, and 34).

Claim 1 is representative of the claims on appeal, and it reads as follows (with emphasis added on the argued portion of the claim):

1. A gain controller, comprising:

a measurement module including program instructions to measure a power level of an outgoing voice signal stream before the outgoing voice signal stream enters an output channel that is communicating the outgoing voice signal stream to a Public Switched Telephone Network (PSTN);

a gain factor setting module including program instructions to set a gain value by comparing the measured power level to a threshold; and

a gain adjustment module including program instructions to adjust the power level of the outgoing voice signal stream by applying the gain value to the outgoing voice signal stream to operate within compliance of the PSTN *before the outgoing voice signal stream enters the output channel in communication with the PSTN.*

(Claim 1 (emphasis added)).

The prior art relied upon by the Examiner in rejecting the claims on appeal is:

Smith

US 5,267,322

Nov. 30, 1993

The Examiner rejected claims 1 to 37 under 35 U.S.C. § 102(b) based upon the teachings of Smith.

In all of the independent claims on appeal, gain control is performed on a voice signal stream “before the outgoing voice signal stream enters the output channel in communication with the PSTN” (Fig. 2; claims 1, 7, 21, 27, and 34), except for claim 14 which only differs by one word and performs gain control “before the outgoing voice signal stream enters *an* output channel in communication with the PSTN” (claim 14 (emphasis added)).

The Examiner contends, *inter alia* (Ans. 3) that Smith’s Figure 1A, column 5 lines 27 to 29, and column 1, lines 25-29 discloses this gain control feature recited in each of the independent claims on appeal. The Examiner reasons (Ans. 8-10; Supp. Ans. 4-5) that because Smith (i) teaches performing gain control on incoming voice signals that enter a PSTN 70 (*see* col. 1, ll. 25-40 and col. 5, ll. 27-29), (ii) does not state that gain control acts *only* on incoming signals, and (iii) has voice calls that include signaling in both directions, outgoing voice signals must necessarily be gain controlled since Smith’s voice signals are necessarily “bidirectional and would be gain controlled in order to meet the known standards of the PSTN” (Supp. Ans. 5). The Examiner also requests that the Board “consider how obvious it would be to use the disclosed gain control of Smith to allow a terminal or

PBX to meet known PSTN standards when connecting to the PSTN” (Supp. Ans. 5).

In response, Appellant argues (App. Br. 10-13) that Smith does not describe an output channel for voice signals that is gain controlled before entering an output channel connected to the PSTN as recited in each of the independent claims discussed *supra*. Appellant contends (Supp. Reply Br. 16) that just because Smith’s gain control *may* be used on outgoing calls to a PSTN does not mean that Smith’s gain control system *must necessarily* be used for outgoing calls to the PSTN. Appellant also contends that Smith does not describe or teach “a PBX that provides an outgoing voice signal stream that enters an output channel that is communicating to a PSTN” since doing so “would be contrary to the purpose of a PBX that functions as a call switching device owned and operated by a private company that makes it possible for an organization to make calls within their own organization without using the external phone company” (Supp. Reply Br. 23).

Smith describes gain control of an incoming voice stream signal for a call processing and voice messaging system coupled to a PSTN (col. 1, ll. 25-40). Smith also describes receiving incoming calls on a public switched telephone line 70 (Fig. 1A; col. 5, ll. 27-29). Although Smith does indeed show an output to a PBX or central office switch (on line 70 shown in Fig. 1A), Smith is silent as to whether or not (i) the PBX or central office switch is connected to a PSTN, (ii) any outgoing signal is gain controlled, and (iii) there is two-way communication to a PSTN with gain control on both incoming and outgoing signals.

Thus, we agree with Appellant's arguments (App. Br. 10-13; Reply Br. 10-21; Supp. Reply Br. 22-24) that Smith does not disclose or teach the feature found in each of independent claims 1, 7, 14, 21, 27, and 34 of performing gain control on a voice signal stream before that outgoing voice signal stream enters an output channel in communication with a PSTN. We agree with Appellant (Supp. Reply Br. 15-16) that it does not *necessarily flow* from the teachings of Smith that outgoing signals would be gain controlled just because incoming signals might be gain controlled. We also agree with Appellant "there is no indication in the Smith reference that the voice messaging system operates on any calls other than incoming calls" (Supp. Reply Br. 17) and that inherency may not be established by probabilities or possibilities, i.e., the mere fact that a thing may result from a given set of circumstances is not sufficient to establish anticipation or even inherency (Supp. Reply Br. 16 citing *In re Robertson*, 169 F.3d 743, 745 (Fed. Cir. 1999)). We do not consider whether or not it would have been obvious to perform gain control on a PBX to meet PSTN standards to connect to a PSTN since the rejection before us on appeal is an anticipation rejection.

In summary, the anticipation rejection of claims 1 to 37 is reversed because each and every limitation in the claims is not found either expressly or inherently in Smith. *In re Crish*, 393 F.3d 1253, 1256 (Fed. Cir. 2004).

The decision of the Examiner is reversed.

REVERSED

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